

REMARKS

At the time of the Office Action dated October 6, 2004, claims 1-20 were pending, all of which stand rejected. In this Amendment, claims 1-6, 8, 13 and 16-20 have been amended to improve wording. Care has been exercised to avoid the introduction of new matter.

Claims 1-20 have been rejected under 35 U.S.C. §102(e) as being anticipatec by Robertson.

Despite the June 23, 2004 response, the Examiner maintained his position on rejecting claims 1-20 under 35 U.S.C. §102(e) based on Robertson, asserting that the reference discloses the claimed invention by specifically citing its column 13, lines 10-36.

In response, Applicants submit that Robertson does not identically disclose the claimed invention within the meaning of 35 U.S.C. §102 for the reasons set forth below. *See Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Applicants specifically emphasize that the claimed invention is not anticipated by Robertson because:

- (i) in the claimed invention, people who receive an incentive are those who used a service, while in Robertson, people who used a service do not receive an incentive; and
- (ii) in the claimed invention, a content of the incentive is modified depending on how many people use the service, while Robertson does not.

As to difference (i), the claimed invention is configured to count the number of terminals that have transmitted a request for a service, and provides information representing an incentive

to the terminal which have transmitted the request. Therefore, people (terminals) who receive such incentive are those who have requested the service in the claimed invention.

Robertson discloses a gift registry service system in which a registered person registers a desired item on a wish list, so that other people can present that item to the registered person. For example, if 100 people register a specific item on their wish lists, a service provider site is notified that that item is registered by total 100 people. The service provider site offers a special rate for that item to potential purchasers. Accordingly, 100 people who registered that item do not receive an incentive, but potential purchasers receive one.

Therefore, the claimed invention is different from what is disclosed in Robertson because the claimed invention provides an incentive to people who requested a service.

For difference (ii), the claimed invention is configured for modifying a content of an incentive in accordance with the number of terminals which have transmitted a request for a service. However, Robertson is silent on modification of a content of an incentive, although the Examiner cited column 13, lines 5-20 of Robertson. The Examiner's cited portion merely discloses, "target audience lists may be automatically sent to the Service Providers upon reaching some threshold for an item of interest" and "For example, an SP may register to be notified when 100 individuals register a particular item of interest," (column 13, lines 12-16). Therefore, the claimed invention is different from Robertson because the claimed invention allows a content of the incentive to be modified depending the number of terminals which transmitted the request.

Accordingly, Applicants submit that Roberson does not identically disclose the claimed invention in the meaning of 35 U.S.C. §102. Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 1-20 and favorable consideration thereof.

Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 SAB:TT
Facsimile: 202.756.8087
Date: February 4, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**

WDC99 1037420-1.059684.0011